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EXAMINER				
BATTAGLIA, MICHAEL V				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/540,705

Applicant(s)

MARTENS ET AL.

Examiner

MICHAEL V. BATTAGLIA

Art Unit

2627

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4 is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-9 and 11 is/are rejected.
- 7) ☒ Claim(s) 10 and 12-15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 April 2007 and 24 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Drawings

1. The replacement drawings were received on April 9, 2007. These drawings are acceptable.

Claim Objections

2. Applicant is advised that should claim 1 be found allowable, claim 3 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). Here claims 1 and 3 cover the same thing because claim 3 is directly dependent on claim 1 and only repeats a limitation already found in claim 1.

Claim Rejections - 35 USC § 112

3. Claim 2 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 1 includes the limitation that “the secondary radiation controller is adapted to control the beam to create a combination of the marks and secondary marks” where the marks and secondary marks are written “in a selected part of the track.” Claim 2, which depends on claim 1, includes the limitation that “the secondary radiation controller is adapted to control the beam to write only secondary marks in the selected part of the track.” If the secondary radiation controller writes **only secondary marks** in the selected part of the track, the secondary radiation controller cannot also write a

combination of the **marks and secondary marks** in the selected part of the track. Therefore, one skilled in the art would require undue experimentation to make and use a device with a secondary radiation controller that writes a combination of marks and selected marks in a selected part of a track and writes only secondary marks in the selected part of the track.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3, 5-9 and 11 are rejected under 35 U.S.C. 102(e) as being anticipated by Kobayashi et al. (hereinafter Kobayashi) (US 6,963,529).

In regard to claim 1, Kobayashi discloses a device (Fig. 2) for recording information by writing marks (Fig. 4, elements P1 and P2 and “pit row in accordance with the audio data SA” of Col. 4, lines 6-11) in a track on a record carrier (Fig. 2, element 2 and Fig. 4, element 40) via a beam of radiation, the device comprising a head (Fig. 2, elements 6, 8 and 9) configured to provide the beam, a radiation controller (Fig. 2, elements 11 and 13) configured to control the beam to write the marks in a selected part of the track, the marks having a main mark intensity (“ON” intensity where the mark is not locally narrowed (Col. 3, lines 57-63 and Col. 17, line 64-Col. 18, line 7)) and a mark length within a predefined range of mark lengths (Col. 13, lines 11-23), and a secondary radiation controller (Fig. 2, elements 7 and 14) configured to control the beam to write secondary marks (Fig. 4, locally narrow portions of pits P1) in the same selected

part of the track (Fig. 4 and Col. 6, lines 4-15), the secondary marks having a secondary mark intensity that is substantially different from the main mark intensity (Fig. 4 and Col. 17, line 64-Col. 18, line 7) and a length substantially longer than mark lengths in the predefined range (Col. 13, lines 37-43), wherein the secondary radiation controller is adapted to control the beam to create a combination of the marks and secondary marks (Fig. 4 and Col. 6, lines 4-15), and wherein the marks, located at an area of track having a secondary mark, have a main mark intensity different from the main mark intensity of marks located at an area of the track not having a secondary mark (Fig. 4; Col. 6, lines 4-15; and Col. 17, line 64-Col. 18, line 7).

In regard to claim 3, Kobayashi discloses that the secondary radiation controller is adapted to control the beam to write a combination of the marks and the secondary marks (Fig. 4).

In regard to claim 5, Kobayashi discloses that the secondary radiation controller is arranged to write the secondary marks by controlling a writing power of the radiation of the beam to secondary level that is substantially lower than a writing power for writing the marks (Fig. 4 and Col. 17, line 64-Col. 18, line 7).

In regard to claim 6, Kobayashi discloses that the secondary radiation controller is arranged to write the secondary marks by controlling the shape of the beam (Col. 4, lines 31-43 and Col. 6, lines 4-15) by an adjustable optical element (Fig. 2, element 7; Col. 3, lines 57-63; and Col. 17, line 64-Col. 18, line 7).

In regard to claim 7, Kobayashi discloses a record carrier (Fig. 2, element 2 and Fig. 4, element 40) carrying information represented by marks (Fig. 4, elements P1 and P2 and "pit row in accordance with the audio data SA" of Col. 4, lines 6-11) in a track ("track" of Col. 4, lines 9-

11 and Col. 13, line 42), the marks in at least a part of the track having a main mark intensity ("ON" intensity where the mark is not locally narrowed (Col. 3, lines 57-63 and Col. 17, line 64-Col. 18, line 7)) and a mark length within a predefined range of mark lengths (Col. 13, lines 11-23), and the same part of the track further comprising secondary marks (Fig. 4, locally narrow portions of pits P1) having a secondary mark intensity that is substantially different from the main mark intensity (Fig. 4 and Col. 17, line 64-Col. 18, line 7), and the secondary marks having a length substantially longer than mark lengths in the predefined range (Col. 13, lines 37-43), wherein the marks located at an area of track having a secondary mark have a main mark intensity different from the main mark intensity of marks located at an area of the track not having a secondary mark (Fig. 4; Col. 6, lines 4-15; and Col. 17, line 64-Col. 18, line 7).

In regard to claim 8, Kobayashi discloses that said different secondary mark intensity is constituted by the secondary marks being effectively narrower than the marks (Fig. 4; Col. 6, lines 4-15; and Col. 17, line 64-Col. 18, line 7).

In regard to claim 9, Kobayashi discloses a method of recording information which corresponds to the function of the device for recording information of claim 1 (see rejection of claim 1 above).

In regard to claim 11, Kobayashi discloses a device (Fig. 5) for reading information (Fig. 5, element SA) represented by marks (Fig. 4, elements P1 and P2) and additional information (Fig. 5, element SB) represented by secondary marks (Fig. 4, locally narrow portions of pits P1) from a track on a record carrier (Figs. 4 and 5, element 40) via a beam of radiation ("laser beam" of Col. 9, line 34), the marks having a main mark intensity ("ON" intensity where the mark is not locally narrowed (Col. 3, lines 57-63 and Col. 17, line 64-Col. 18, line 7)) and mark lengths

within a predefined range of mark lengths (Col. 13, lines 11-23), the secondary marks having a secondary mark intensity that is substantially different from the main mark intensity (Fig. 4 and Col. 17, line 64-Col. 18, line 7) and a length outside the predefined range of mark lengths (Col. 13, lines 37-43), and the marks and the secondary marks being in the same selected part of the track (Fig. 4), the device comprising a head (Fig. 5, element H) configured to provide the beam, a front-end unit (Fig. 5, elements 43 and 45) configured to generate a scanning signal (Fig. 5, element BD) for detecting marks and secondary marks during said scanning, a read processing unit (Fig. 5, elements 47 and 48) configured to retrieve the information from the scanning signal, and a secondary read unit (Figs. 5 and 6, element 50) configured to retrieve additional information encoded in the secondary marks from the scanning signal (Col. 10, lines 13-23), wherein the marks located at an area of track having a secondary mark have a main mark intensity different from the main mark intensity of marks located at an area of the track not having a secondary mark (Fig. 4; Col. 6, lines 4-15; and Col. 17, line 64-Col. 18, line 7).

Allowable Subject Matter

5. Claim 4 is allowed for the reasons specified in Applicant's marks (also see the reasons specified in the previous Office action).
6. Claims 10 and 12-15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

In regard to claim 10, none of the references of record alone or in combination suggest or fairly teach a method including all the limitations of claim 9 and wherein said controlling writing

the marks is performed at a first instance in time and writing the secondary marks is performed at a different instance in time during two separate scans of the selected part of the track.

In regard to claims 12-15, none of the references of record alone or in combination suggest or fairly teach a device for recording, record carrier, method or device for reading including all the limitations of claims 1, 7, 9 or 11, respectively, and wherein a scanning signal level difference between marks and intermediate spaces is substantially equal at both areas of the track.

Response to Arguments

7. Applicant's arguments filed April 9, 2007 with respect to claims 1-3, 5-9 and 11 have been fully considered but they are not persuasive. Applicant argues that the claims have "been amended to contain the subject matter indicated as allowable in claim 4" (Page 13). However, the claims have been amended to only contain a portion of the subject matter indicated as allowable in claim 4. The subject matter indicated as allowable in claim 4 additionally includes the limitation that "a scanning signal level difference between marks and intermediate spaces is substantially equal at both areas of the track," and this limitation is not found in any of claims 1-3, 5-9 and 11.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL V. BATTAGLIA whose telephone number is (571)272-7568. The examiner can normally be reached on M-F, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, A. Wellington can be reached on (571) 272-4483. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael V. Battaglia/
Primary Examiner, Art Unit 2627

/Andrea L Wellington/
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